

the term is appropriate and that being their own lexicographers, Applicants should be allowed to use the term they have chosen. As set forth in the American Heritage Dictionary of the English Language, Fourth Edition, (which may be found at [www.yourdictionary.com](http://www.yourdictionary.com), and is attached hereto as Exhibit A), the term “demographics” is defined as “the characteristics of human populations and population segments, especially when used to identify consumer markets.” The dictionary includes an example of the use of the term in a sentence, the example reads: “the demographics of the Southwest indicate a growing population of older consumers.” *Id.* (emphasis added). Substituting the term “business” for the term “Southwest” in this example (as both are subsets of the population), demonstrates that in context, the term demographics may be used to describe the collective characteristics of the individual people within a business. Accordingly, while the Examiner is thanked for his suggested amendment, the term “demographics” is the term Applicants wish to use in the claims.

For at least these reasons, reconsideration and withdrawal of the rejection under 35 U.S.C. § 112, second paragraph, are respectfully requested.

#### Rejections Under 35 U.S.C. § 103

Claims 1-38 stand rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Giovannoli (U.S. Patent No. 5,758,328). Applicants respectfully traverse this rejection and request withdrawal thereof for at least the reasons set forth below. Applicants respectfully submit that no *prima facie* case of obviousness has been established. As the Examiner is aware, a *prima facie* case of obviousness requires the following: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; (2) there must be a reasonable expectation of success; and (3) the prior art reference (or references when

combined) must teach or suggest all the claim limitations. MPEP at 2143. Applicants submit that none of these criterion have been met.

With regard to the first criterion, Giovannoli fails to provide any motivation to modify the reference to apply it to telecommunication services, which is recited in each of the claims. As noted by the Examiner, Giovannoli does not teach or suggest the purchase and sale of telecommunication services. The Examiner has not shown any indication in Giovannoli that it is "analogous prior art" to telecommunication services as alleged in the Office Action (p. 6, lines 1-4 of Action). Applicants submit that the contention that Giovannoli is allegedly analogous art over simplifies the obviousness analysis.

The Examiner has provided no evidence as to why one skilled in the art would be motivated to even attempt to translate the system of Giovannoli into the present invention. Thousands, perhaps millions, of Americans receive telephone solicitations offering various telephone services on a daily basis. Many of these calls are unwanted altogether, others are taken by consumers who then switch telephone services based on intimidation, "quick selling", or cheap enticements such as limited rebates, free minutes, or small cash offers. An industry of telemarketers revolves around this process. Consumers have beckoned for change. (See the January 21, 2000, comments by Colorado Attorney General, Ken Salazar at <http://www.ago.state.co.us/PRESREL/presrl00/prsrl4.htm> attached hereto as Exhibit B). The U.S. government is bereft with ideas of how to solve the problems associated with telephone solicitations, except to work with and monitor the telephone companies. The present invention offers a novel, pro-active, and consumer oriented solution to this problem, which heretofore has not been presented to the public. Giovannoli does not even recognize, much less offer solutions to these problems.

The Examiner has made a broad allegation that the system of Giovannoli would be “capable” of purchasing and selling telecommunication services within the metes and bounds of the present application. This hindsight analysis, however, does not establish a *prima facie* case as motivation to modify must be found in the references themselves. The question is not whether Giovannoli is “capable” of performing the claimed invention, but rather if the reference itself teaches or suggests the claimed process. It does not.

The Office Action does not establish that Giovannoli would have motivated one with no knowledge of the invention at issue to make the [modification] in the manner that is claimed. *See In re Kotzab*, 55 U.S.P.Q.2d 1313 (Fed. Cir. 2000). For at least this reason, the present invention is neither anticipated by nor obvious in view of Giovannoli.

Additionally, the second prong of the obviousness analysis requires that the reference provide a reasonable expectation of success if the modification is in fact made, which Giovannoli does not provide. The reasonable expectation of success must be found in the prior art, not in the applicant’s disclosure. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991). There is no indication in Giovannoli or in any of the Examiner’s statements, which would lead one to conclude that there was a reasonable expectation of successfully translating Giovannoli into a process for buying and selling telecommunication services. It appears that impermissible hindsight is being used in order to try to find an expectation of success. Consequently, the Applicants assert that this prong of a *prima facie* obviousness case has also not been established.

Lastly, the third prong has not been met. Giovannoli does not teach or suggest all the elements of the present invention.<sup>1</sup> In particular, Giovannoli does not teach or suggest, for

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<sup>1</sup> As indicated above, in order to establish that the claimed invention is *prima facie* obvious, all the claim limitations must be taught or suggested by the prior art. *See In re Royka*, 490 F.2d 981 (C.C.P.A. 1974).

example, the claim recitation that requests are made for “telecommunication services” or that the request for service is directed specifically to a “provider of telecommunication services.” *See, e.g.*, independent claims 1, 13, 26, 30, 35, and 37. The present invention is directed specifically to telecommunication services, the limitation may be found in one or more elements of each claim. Giovannoli does not teach or suggest these elements. Consequently, Applicants assert that this prong of the *prima facie* obviousness case has not been established.

For at least these reasons, Applicants respectfully request reconsideration and withdrawal of this rejection.

The Examiner addresses claims 7 and 20 separately. Claims 7 and 20 depend from claims 1 and 14, respectively. Applicants submit that for at least the same reasons, claims 1 and 14 are unobvious over Giovannoli, claims 7 and 20 are likewise unobvious. Accordingly, Applicants respectfully request reconsideration and withdrawal of this aspect of the rejection as well.

#### CONCLUSION

In view of the above remarks, Applicants respectfully submit that the present application is in condition for allowance. Accordingly, withdrawal of all outstanding rejections and allowance of the application are respectfully requested. If the Examiner has any questions regarding this submission, the Examiner is invited to contact the undersigned at the telephone number provided.


Applicants hereby request any extensions of time deemed necessary for entry of this communication or to maintain the pendency of this application. Please charge any extension or

other necessary fees, or credit any overpayment of fees associated with this communication to

Deposit Account No. 50-2228. A duplicate copy of this communication is attached.

Respectfully submitted,

Date: 5/9/03

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